

REMARKS

I. Introduction

In response to the Office Action dated April 16, 2002, claims 4, 5, 14, 15, 24 and 25 have been cancelled, and claims 1, 11 and 21 have been amended. Claims 1-3, 6-13, 16-23 and 26-30 remain in the application. Reconsideration of the application, as amended, is requested.

II. Claim Amendments

Applicant's attorney has made amendments to the claims as indicated above. These amendments were made for the purpose of clarifying the language of the claims, and were not required for patentability or to distinguish the claims over the prior art. These amendments are fully supported by the claims of the application as originally filed. Claims 1, 11 and 21 were amended solely by introducing the limitations of originally-filed claims 5, 15 and 25, respectively.

III. Prior Art Rejections

A. Fernandes Reference

In paragraph (3) of the Office Action, the Examiner stated that "35 USC 102(b) rejections are changed to 35 USC 103(a) rejections since pending claims appear to be well-known practices". Paragraphs (3)-(9) of the Office Action proceed to discuss the Fernandes reference and the case law pertaining to determinations of obviousness. It is not clear, however, whether the rejection in view of Fernandes is withdrawn or maintained as a rejection under 35 USC §103(a). In the event that the rejection in view of Fernandes is maintained, Applicant respectfully traverses this rejection.

General statements are made in paragraph (3.A) of the Office Action that a shopping environment is inherently suggested in Fernandes. Consideration of an inherent quality, however, is relevant only to anticipation, not obviousness. *Jones v. Hardy*, 230 USPQ 1021, 1025 (Fed. Cir. 1984). In finding the invention (polystyrene mold for construction of a concrete wall) nonobvious, the *Jones* court noted that consideration must be given to the invention as a whole, not the "degree of inventiveness".

Paragraph (3B) of the Office Action states that Applicant cannot argue limitations not in the claim, in connection with Applicant's prior arguments that referenced advantages discussed at page 7

of the specification. Applicant respectfully notes that it is permissible to argue unobviousness of a claim limitation by referring to advantages of the invention that were not appreciated in the prior art. Page 7 of the specification discusses advantages that flow from the claimed invention. The lack of appreciation for these advantages further supports Applicant's arguments that the prior art fails to provide a motivation to combine or alter the teachings of the cited references to arrive at the claimed invention.

At paragraph (5) of the Office Action, it is asserted that "the cited references [sic] read-on the claims presented by the applicant". However, no indication of how each element is met by the cited reference(s) is provided to support this assertion. This is true for each element of the independent claims and for the further elements recited in the dependent claims.

Fernandes does not teach or suggest co-browsing, nor does Fernandes teach co-browsing by users shopping over a computer network, nor does it teach coordinating and combining the co-browsing with the experience of shopping at a network site. Fernandes makes no mention or suggestion of a shopping environment. Instead, Fernandes teaches away from Applicant's invention because it describes chat rooms for online communities and the move toward adding audio and video exchanges and toward developing an ability to share and collaborate on documents in the context of a meeting environment.

B. Alaia, Hodges and Sakamoto References

In paragraph (11) of the Office Action, claims 1-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Alaia et al., U.S. Patent No. 6,230,146 (Alaia) in view of Hodges et al.'s book on multimedia computing, 1993 (Hodges), and further in view of Sakamoto et al.'s IEEE article (Sakamoto). The only article by Sakamoto included in the Notice of References Cited is dated August 31, 2000. Sakamoto is not prior art to the instant application and cannot form the basis for a rejection under 35 U.S.C. §103(a). Accordingly, Applicant requests that the rejection under 35 U.S.C. §103(a) be withdrawn.

Although the rejection under 35 U.S.C. §103(a) is not valid because it relies on a reference dated after the filing date of the present application, Applicant states the following for the record to clarify that Alaia and Hodges, taken alone or in combination, fail to teach or suggest the claimed invention.

Applicant respectfully notes that Alaia was not included in the Notice of References Cited that accompanied the Office Action. Applicant requests that Alaia be formally noted in the record so that examination on the basis of this reference is acknowledged on the front page of the patent that issues from this application. In addition, although Applicant has obtained a copy of Alaia et al., U.S. Patent No. 6,230,146, no relevant portion of this reference is identified in the Office Action, nor is a relevant portion apparent to Applicant based on the review of Alaia. Accordingly, Applicant has made a good faith effort hereinbelow to address the teachings of Alaia.

Independent claims 1, 11, and 21 are generally directed to a method, apparatus and computer program carrier for providing co-browsing by users shopping over a computer network. The method comprises providing a network site offering items for sale, monitoring the browsing patterns of a first user of the network site and of a second user of the network site, identifying a common browsing pattern of the first and second users, informing the users of the common browsing pattern, providing to the first user of the network site capability to inform the network site of interest in co-browsing with the second user, providing to the second user of the network site capability to inform the network site of interest in co-browsing with the first user, and providing a capability for communication between the interested first and second users while they continue to shop on the network site.

The cited references do not teach nor suggest these various elements of Applicant's independent claims.

Alaia merely describes a method and system for conducting electronic auctions. A dynamic lot closing extension feature avoids collisions in closing times of multiple lots by dynamically extending the closing time of a subsequent lot if a preceding lot's closing time is extended to be too close to the subsequent lot's then-currently scheduled closing time. Scheduled closing times can be extended with a flexible overtime feature, in which the properties of the event triggering the extension and the duration of the overtime period(s) can be tailored to a particular auction, particular lots of products within an auction, and to the particular time within an auction process. The bidding status of a lot can be set to a "pending" status after the nominal closing time for submission of bids to allow bidders to alert the auction coordinator of technical problems in submission of bids. This allows the possibility for a lot to be return to open status for further bidding by all bidders. The auction may be paused by the auction coordinator to correct technical,

market and miscellaneous problems that may arise during the course of an auction. Individual bid ceilings can be set for each bidder so that they are required to bid lower than certain thresholds determined in advance of the auction. Failsafe error detection is performed to prevent erroneous bids from entering the auction. The auction coordinator has the ability to override any erroneous bids that are entered to prevent prejudice to the auction.

Alaia lacks any discussion about providing a user with the capability of indicating interest in co-browsing with another user while shopping at a network site. Nor does Alaia provide any discussion about monitoring the users' browsing patterns and informing them of common patterns and/or common interests. Instead, Alaia teaches away from Applicant's invention because it describes an environment in which communication occurs between a bidder and an auction coordinator. Communication between bidders is not taught or suggested in Alaia.

Hodges merely describes an environment in which the user reviewing a real estate database is provided with a button in the interface for each house within the database that allows the user to call a realtor via telephone. The user can select parameters for the telephone call among: voice only, voice and video, and voice with video and shared graphics and data. The call begins voice only, with the option of switching to a shared data mode, in which both the realtor and the user can view the same data on screen, even with financial figures entered by the realtor. However, like Alaia, Hodges lacks any discussion about communication between users shopping at a network site, nor does it teach or suggest providing for communication between first and second users identified by their common browsing pattern and informed of each other's common browsing pattern.

Even when combined, the references teach away from Applicant's invention. For example, the combined references would teach providing for communication between a pre-determined party (auction coordinator or realtor) and a user. Not one of the cited references teaches any of the steps of (1) monitoring the browsing of users, (2) identifying common browsing patterns, and (3) informing users of their common browsing patterns, together with providing a capability for communication between the interested first and second users while they shop on the network site.

Moreover, the various elements of Applicant's claimed invention together provide operational advantages over the cited references. In addition, Applicant's invention solves problems not recognized by the cited references.

Thus, Applicant submits that independent claims 1, 11, and 21 are allowable over the cited references. Further, the dependent claims are submitted to be allowable over the cited references in the same manner, because they are dependent on independent claims 1, 11, and 21, respectively, and thus contain all the limitations of the independent claims. In addition, the dependent claims recite additional novel elements not shown by the cited references.

C. Additional Remarks

In paragraph (12) of the Office Action, additional remarks were added. One remark is an assertion that "there is nothing different between the way of communicating while browsing the Internet (e.g., 2 friends are on the telephones talking about a particular price of an item on amazon.com site . . . [and] 'co-browsing' and 'communication' between 2 users' actions". Applicant respectfully notes that this is quite different from the claimed invention. The Examiner's example requires two friends who are already acquainted with each other and know how to contact one another to discuss their shopping interests. The claimed invention, in contrast, provides a capability for making co-browsers aware of each other's presence who otherwise would not have known of their common interest, nor would they have been able to contact one another to communicate.

A second remark at paragraph (12) asserts that merely automating (by computers) a known human process using well-known automation techniques is not patentable. Applicant asserts that the claimed invention relates to a method that has no well-known counterpart in conventional (non-Internet) shopping. In conventional shopping environments, co-browsers can see each other and have the capability to identify their common interests and communicate without requiring assistance from the vendor. Accordingly, the claimed invention addresses a need previously unrecognized.

Finally, Applicant acknowledges the list of references discussed in paragraph (14) of the Office Action. These references are not listed on the Notice of References Cited, are not available to Applicant, and do not appear to be prior art.

IV. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that

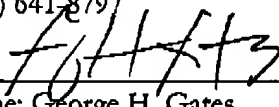
can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

Respectfully submitted,

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APPENDIX: VERSION WITH MARKINGS TO SHOW CHANGES MADE

1. (Amended) A method for providing co-browsing by users shopping over a computer network, comprising the steps of:
- (a) providing a network site offering items for sale;
 - (b) monitoring the browsing patterns of a first user of the network site and of a second user of the network site;
 - (c) identifying a common browsing pattern of the first and second users;
 - (d) informing the users of the common browsing pattern;
 - (e) providing to [a] the first user of the network site capability to inform the network site of interest in co-browsing with [a] the second user;
 - [(c)] (f) providing to the second user of the network site capability to inform the network site of interest in co-browsing with the first user; and
 - [(d)] (g) providing a capability for communication between the interested first and second users while they continue to shop on the network site.
11. (Amended) An apparatus for providing co-browsing by users shopping over a network, comprising:
- (a) an electronic commerce server connected to the network for offering items for sale; and
 - (b) a co-browsing facility, provided by the electronic commerce server, that allows a first user that is browsing the items for sale to conditionally know whether a second user is also browsing the items for sale and then provides a communication medium for a conversation between the first and second users via the electronic commerce server while the first and second users both continue

to browse the items for sale on the network site, wherein the electronic commerce server is capable of monitoring the browsing pattern of at least one of the first or second users, and wherein the electronic commerce server is further capable of identifying at least two users of a common browsing pattern and informing the at least two users of the common browsing pattern.

21. (Amended) An article of manufacture comprising a computer program carrier readable by a computer and embodying one or more instructions executable by the computer to perform method steps for:

- (a) providing a network site offering items for sale;
- (b) monitoring the browsing patterns of a first user of the network site and of a second user of the network site;
- (c) identifying a common browsing pattern of the first and second users;
- (d) informing the users of the common browsing pattern;
- (e) providing to [a] the first user of the network site capability to inform the network site of interest in co-browsing with [a] the second user;
- [(c)] (f) providing to the second user of the network site capability to inform the network site of interest in co-browsing with the first user; and
- [(d)] (g) providing a capability for communication between the interested first and second users while they continue to shop on the network site.